

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

PCT

To:

RANBAXY LABORATORIES LIMITED
c/o DESHMUKH Jay R.
600 College Road East, Suite 2100
Princeton 08540
ETATS-UNIS D'AMERIQUE

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NOTIFICATION OF TRANSMITTAL OF
THE INTERNATIONAL PRELIMINARY
REPORT ON PATENTABILITY

(PCT Rule 71.1)

Date of mailing
(day/month/year)

15.02.2005

Applicant's or agent's file reference:
RLL-330WO

IMPORTANT NOTIFICATION

International application No.
PCT/IB2004/000010

International filing date (day/month/year)
07.01.2004

Priority date (day/month/year)
07.01.2003

Applicant

RANBAXY LABORATORIES LIMITED

1. The applicant is hereby notified that this International Preliminary Examining Authority transmits herewith the international preliminary report on patentability and its annexes, if any, established on the international application.
2. A copy of the report and its annexes, if any, is being transmitted to the International Bureau for communication to all the elected Offices.
3. Where required by any of the elected Offices, the International Bureau will prepare an English translation of the report (but not of any annexes) and will transmit such translation to those Offices.
4. **REMINDER**

The applicant must enter the national phase before each elected Office by performing certain acts (filing translations and paying national fees) within 30 months from the priority date (or later in some Offices) (Article 39(1)) (see also the reminder sent by the International Bureau with Form PCT/IB/301).

Where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary report on patentability. It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned.

For further details on the applicable time limits and requirements of the elected Offices, see Volume II of the PCT Applicant's Guide.

The applicant's attention is drawn to Article 33(5), which provides that the criteria of novelty, inventive step and industrial applicability described in Article 33(2) to (4) merely serve the purposes of international preliminary examination and that "any Contracting State may apply additional or different criteria for the purposes of deciding whether, in that State, the claimed inventions is patentable or not" (see also Article 27(5)). Such additional criteria may relate, for example, to exemptions from patentability, requirements for enabling disclosure, clarity and support for the claims.

Name and mailing address of the international preliminary examining authority:

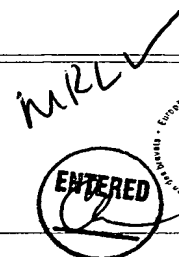


European Patent Office - Gitschiner Str. 103
D-10958 Berlin
Tel. +49 30 25901 - 0
Fax: +49 30 25901 - 840

Authorized Officer

HALBARTSCHLAGER, M


Tel. +49 30 25901-714



PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY (Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference RLL-330WO		FOR FURTHER ACTION		See Form PCT/PEA/416
International application No. PCT/B2004/000010		International filing date (day/month/year) 07.01.2004		Priority date (day/month/year) 07.01.2003
International Patent Classification (IPC) or national classification and IPC C07D401/12, A61K31/4184, A61P1/04				
Applicant RANBAXY LABORATORIES LIMITED				
<p>1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of 6 sheets, including this cover sheet.</p> <p>3. This report is also accompanied by ANNEXES, comprising:</p> <p>a. <input type="checkbox"/> sent to the applicant and to the International Bureau a total of sheets, as follows:</p> <p><input type="checkbox"/> sheets of the description, claims and/or drawings which have been amended and are the basis of this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).</p> <p><input type="checkbox"/> sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.</p> <p>b. <input type="checkbox"/> (sent to the International Bureau only) a total of (indicate type and number of electronic carrier(s)) , containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).</p>				
<p>4. This report contains indications relating to the following items:</p> <p><input checked="" type="checkbox"/> Box No. I Basis of the opinion</p> <p><input type="checkbox"/> Box No. II Priority</p> <p><input checked="" type="checkbox"/> Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</p> <p><input type="checkbox"/> Box No. IV Lack of unity of invention</p> <p><input checked="" type="checkbox"/> Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</p> <p><input type="checkbox"/> Box No. VI Certain documents cited</p> <p><input type="checkbox"/> Box No. VII Certain defects in the international application</p> <p><input type="checkbox"/> Box No. VIII Certain observations on the international application</p>				
Date of submission of the demand 04.08.2004		Date of completion of this report 15.02.2005		
Name and mailing address of the international preliminary examining authority:  European Patent Office - Gitschiner Str. 103 D-10958 Berlin Tel. +49 30 25901 - 0 Fax: +49 30 25901 - 840		Authorized Officer Hoepfner, W Telephone No. +49 30 25901-337		



**INTERNATIONAL PRELIMINARY REPORT
ON PATENTABILITY**

0/541140
JC20 Rec'd PCT/PTO 30 JUN 2009
International application No.
PCT/B2004/000010

Box No. I Basis of the report

1. With regard to the **language**, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.
 - ☐ This report is based on translations from the original language into the following language , which is the language of a translation furnished for the purposes of:
 - ☐ international search (under Rules 12.3 and 23.1(b))
 - ☐ publication of the international application (under Rule 12.4)
 - ☐ international preliminary examination (under Rules 55.2 and/or 55.3)
2. With regard to the **elements*** of the international application, this report is based on *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report)*:

Description, Pages

1-6 as originally filed

Claims, Numbers

1-28 as originally filed

Drawings, Sheets

1/3-3/3 as originally filed

- ☐ a sequence listing and/or any related table(s) - see Supplemental Box Relating to Sequence Listing
3. ☐ The amendments have resulted in the cancellation of:
 - ☐ the description, pages
 - ☐ the claims, Nos.
 - ☐ the drawings, sheets/figs
 - ☐ the sequence listing *(specify)*:
 - ☐ any table(s) related to sequence listing *(specify)*:
 4. ☐ This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).
 - ☐ the description, pages
 - ☐ the claims, Nos.
 - ☐ the drawings, sheets/figs
 - ☐ the sequence listing *(specify)*:
 - ☐ any table(s) related to sequence listing *(specify)*:

* If item 4 applies, some or all of these sheets may be marked "superseded."

**INTERNATIONAL PRELIMINARY REPORT
ON PATENTABILITY**

International application No.
PCT/IB2004/000010

Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

1. The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), or to be industrially applicable have not been examined in respect of:

- ☐ the entire international application,
☒ claims Nos. 22-24 (with respect to industrial applicability)

because:

- ☒ the said international application, or the said claims Nos. 22-24 relate to the following subject matter which does not require an international preliminary examination (specify):

see separate sheet

- ☐ the description, claims or drawings (*indicate particular elements below*) or said claims Nos. are so unclear that no meaningful opinion could be formed (*specify*):
- ☐ the claims, or said claims Nos. are so inadequately supported by the description that no meaningful opinion could be formed.
- ☐ no international search report has been established for the said claims Nos.
- ☐ the nucleotide and/or amino acid sequence listing does not comply with the standard provided for in Annex C of the Administrative Instructions in that:
- | | |
|----------------------------|--|
| the written form | <input type="checkbox"/> has not been furnished |
| | <input type="checkbox"/> does not comply with the standard |
| the computer readable form | <input type="checkbox"/> has not been furnished |
| | <input type="checkbox"/> does not comply with the standard |
- ☐ the tables related to the nucleotide and/or amino acid sequence listing, if in computer readable form only, do not comply with the technical requirements provided for in Annex C-*bis* of the Administrative Instructions.
- ☐ See separate sheet for further details

**INTERNATIONAL PRELIMINARY REPORT
ON PATENTABILITY**

International application No.
PCT/IB2004/000010

Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	1-28
	No: Claims	
Inventive step (IS)	Yes: Claims	
	No: Claims	1-28
Industrial applicability (IA)	Yes: Claims	1-21,25-28
	No: Claims	

2. Citations and explanations (Rule 70.7):

see separate sheet

Re Item III

Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

Claims 22-24 relate to subject-matter considered by this Authority to be covered by the provisions of Rule 67.1(iv) PCT. Consequently, the International Examination Authority fully concurs with the objection put forward by the International Search Authority and no opinion will be formulated with respect to the industrial applicability of the subject-matter of these claims (Article 34(4)(a)(I) PCT).

Re Item V

Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

- D1: US-A-5 045 552 (SHIMOMURA NAOYUKI ET AL) 3 September 1991 (1991-09-03)
- D2: WO 98/54171 A (KRONSTROEM ANDERS ; MOELLER EVA (SE); ASTRA AB (SE); COTTON HANNA (SE)) 3 December 1998 (1998-12-03)
- D3: WO 01/36409 A (SHERMAN BERNARD CHARLES) 25 May 2001 (2001-05-25)

Novelty

The document D1 teaches the usefulness of salts of various proton pump inhibitors of the imidazole series in the treatment of peptic ulcer. There are also mentioned Mg salts, however in the worked Examples of D1 there is preference given to sodium salts. The claims clearly encompass the sodium salt of rabeprazole (see column 1, lines 9-12; column 5, lines 58-60; Table 1, compd. no. 19; Example 91; Claims 1, 2).

Consequently, the subject-matter of the present independent claims 1, 5, 15, 22 and 25 and the present dependent claims 2-4, 6-14, 23, 24 and 26-28 can be seen as a formally novel selection from the general teachings of D1.

Inventive step

D1 has to be regarded as the closest prior art for the novel subject-matter, since it addresses the same technical problem, namely the provision of a compound suitable for the treatment of peptic ulcer.

The distinguishing feature between the novel subject-matter and D1 is to be seen as

the particular selection of Mg from the list of possible counterions.

However, in the absence of any evidence for an unexpected technical effect linked to this feature, the objective problem underlying the said novel subject-matter can merely be regarded as the provision of further proton pump inhibitors within the ambit of D1.

The documents D2 and D3 teach Mg salts of omeprazole, a further useful proton pump inhibitor of the benzimidazole series (see **D2**: page 1, lines 17-20; page 3, lines 3-5; **D3**: page 1, lines 19, 20; page 5, line 13).

Starting from D1 and applying the teachings of D2 or D3 to D1, one comes immediately to the claimed solution, namely the selection of Mg as counterion.

Consequently, for this solution, the presence of inventive activity could only be acknowledged, if it could be shown (preferably by suitable experimental data) that this solution brings about (an) unexpected technical effect(s) when compared to the solution already provided by D1 (sodium salt).

Industrial applicability

There is no doubt that the subject-matter of the present claims 1-21 and 25-28 is industrially applicable.

However, for the assessment of the present claims 22-24 on the question whether they are industrially applicable, no unified criteria exist in the PCT Contracting States. The patentability can also be dependent upon the formulation of the claims. The EPO, for example, does not recognize as industrially applicable the subject-matter of claims to the use of a compound in medical treatment, but may allow, however, claims to a known compound for first use in medical treatment and the use of such a compound for the manufacture of a medicament for a new medical treatment.